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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/960,175	09/20/2001	Daniel E. E. Hayes JR.	HAYES-5	4587

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EXAMINER
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PRIDDY, MICHAEL B

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 05/07/2003

5

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/960,175

Applicant(s)

HAYES ET AL.

Examiner

Michael B Priddy

Art Unit

3732

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 4 and 9 recite the limitation "the vertices" in line 2. There is insufficient antecedent basis for this limitation in the claims.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5, 7, 8 and 10-14 are rejected under 35 U.S.C. 102(e) as being anticipated by White (US 6,428,578). White teaches a modular prosthesis 10 comprising a body element 14 and at least one other element 12, wherein said body

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element 14 and said at least one other element 12 are joined together by at least one modular connection 16; and further wherein said body element 14 comprises an anterior wall and a posterior wall, at least one of said anterior wall and said posterior wall converging toward the other on the medial side of said body element and diverging away from the other on the lateral side of said body element, whereby the body element 14 approximates a general wedge shape; wherein said body element 14 further comprises a lateral aspect extending between said anterior wall and said posterior wall; wherein said body element comprises an isosceles triangle configuration; wherein each of said anterior and posterior walls and said lateral aspect are substantially flat.

White also teaches a variation of the prosthesis system wherein body 14 has a substantially flat medial aspect (as shown in Fig. 10).

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Powell (US 5,906,644). Powell teaches a modular prosthesis 10 comprising a body element 24 and at least one other element 20, wherein said body element 24 and said at least one other element 20 are joined together by at least one modular connection 18/22; and further wherein said body element 24, as shown in Fig. 11, comprises an anterior wall and a posterior wall, at least one of said anterior wall and said posterior wall converging toward the other on the medial side of said body element and diverging away from the other on the lateral side of said body element, whereby the body element 24 approximates a general wedge shape; wherein said body element 24 further comprises a lateral aspect extending between said anterior wall and said posterior wall; and wherein the vertices of said body element 24 have a rounded configuration.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over White as applied to claim 3 above, and further in view of the following. White discloses the claimed invention except for the triangular body portion being shaped as an *irregular* triangle. It would have been an obvious matter of design choice to one skilled in the art at the time the invention was made to form the body portion of White in the shape of an irregular triangle, since applicant has not disclosed that such solves any stated problem or is anything more than one of numerous shapes or configurations a person ordinary skill in the art would find obvious for the purpose of providing a forming edge in the heating portion or clamp. In re Dailey and Eilers, 149 USPQ 47 (1966).

Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over White in view of Khalili et al. (US 6,187,050). White teaches a modular prosthesis 10 comprising a body element 14 and at least one other element 12, wherein said body element 14 and said at least one other element 12 are joined together by at least one modular connection 16; and further wherein said body element 14 comprises an anterior wall and a posterior wall, at least one of said anterior wall and said posterior wall converging toward the other on the medial side of said body element and diverging away from the other on the lateral side of said body element, whereby the body element

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14 approximates a general wedge shape; wherein said body element 14 further comprises a lateral aspect extending between said anterior wall and said posterior wall; wherein said body element comprises an isosceles triangle configuration; wherein each of said anterior and posterior walls and said lateral aspect are substantially flat. The prosthesis of White is intended for implantation into a patient during re-constructive arthroplastic surgery as disclosed in lines 5-8 of column 1; lines 50-56 of column 4; lines 59-61 of column 5; and lines 12-16 of column 7.

In lines 38-41 of column 6, White indicates the tapered connector 44 may receive a ball "having the acetabular fit needed to ensure proper articulation".

Hence White teaches all of the limitations of the present invention except a prosthetic acetabular cup component.

Khalili et al. teach an oblong acetabular cup 10 intended to be "implanted in the acetabular cavity in the pelvis to replace the natural acetabulum. Replacement of the acetabulum is necessary when there is an inadequate articulation surface of a head of ball of a prosthetic femoral component." It would have been obvious to one of skill in the art at the time of the present invention to have provided an acetabular cup component with the modular prosthesis 10 of White so that there would be an adequate articulation surface for a ball component received on the tapered connector 44 of neck 22.

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***Allowable Subject Matter***

Claim 9 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael B. Priddy whose telephone number is (703) 308-8620. The examiner can normally be reached on Mon.-Fri. 8 a.m. - 5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Michael B. Priddy  
*Michael B. Priddy*  
April 30, 2003

*Kevin Shaver*  
KEVIN SHAVER  
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5/1/03